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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/902,321

07/10/2001

Michael Lee Vatter

8160

8449

27752

7590

08/03/2007

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

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DELIVERY MODE

08/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/902,321

**Applicant(s)**

VATTER ET AL.

**Examiner**

Gina C. Yu

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/2005, 4/24/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application before board decision. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31, 2005 has been entered.

As indicated in Decision on Petition, rendered on April 17, 2007, applicant's request to vacate the board decision of May 20, 2005 has been rendered moot, and the board decision to affirm the rejection made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated November 20, 2002, is effective.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on March 31, 2005 and April 24, 2007 were filed on and after the mailing date of the request for continuing examination on March 31, 2005, respectively. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. (5,412,004).**

Tachibana is directed to the manufacture of paste-like silicone compositions that can be used in water-in-oil cosmetic emulsions (title and abstract, in a water-in-oil emulsion, water is the discontinuous phase and oil is the continuous phase). Applicant discloses at page 5, lines 4- 11 and page 6, lines 12-14 that the emulsifying crosslinked siloxane elastomers are those disclosed by Tachibana. The water-in-oil cosmetic emulsion of Tachibana may contain various components in the discontinuous phase such as saccharides, sugar alcohols, inorganic salts, polyoxyalkylene-modified organopolysiloxane emulsifiers (surfactants) and cosmetic powders, such as talc, kaolin, mica, titanium dioxide, zinc oxide, red iron oxide, and others (col. 3, line 55 to col. 4, line 18, and Col. 10, line 61-Col. 11, line 6). For solids such as organically modified montmorillonite clay, see col. 8, lines 38-47. For sorbitol, a polyhydric alcohol of claim 4, see col. 9, lines 28-29. For dimethicone copolyol emulsifier, see col. 9, line 38 to col. 10, line 53.

For additional solids and fillers, see col. 10, line 57 to col. 11, line 6. For preservatives and skin conditioning agents such as moisturizers, which encompasses emollients, see col. 11, lines 53- 57. See examples 15-27 for preservatives and forms of the compositions such as foundation, eye shadow, and rouge (blusher).

Tachibana discloses at col. 7, lines 33-39 that the paste-like composition comprises 100 parts by weight of the silicone polymer (emulsifying siloxane elastomer) and 10-1000

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parts by weight of a silicone oil. This is equivalent to 9-90 wt.% of each of the components, which overlaps the instantly claimed percent ranges of claim 14.

Tachibana does not disclose the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer, or the amount of air contained in the composition. It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect.

See In re Boesch, 205 USPQ 215 (CCPA 1988). Therefore, absent evidence of unexpected results, it is considered within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes.

Applicants admit at page 20, lines 8-13 that the compositions may be aerated by hand or mechanical mixing as well as any conventional form of foaming or whipping. It is the Examiner's position that simple stirring would incorporate an amount of air of at least 1% in the compositions. Therefore, the compositions of Tachibana necessarily contain at least about 1% air as instantly claimed. Burden is shifted to Applicant to show that the compositions of Tachibana do not contain the instantly claimed amount of air.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select an optimal droplet size of the discontinuous phase and particle size of the emulsifying siloxane elastomer in the compositions of Tachibana expecting to obtain stable cosmetic water-in-oil emulsions that provide good feeling upon use.

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. as applied to claims 1-10 and 12-14 above, and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., Van Nostrand Reinhold Co., New York (1981) pages 121,385, 434 and 686.**

Tachibana teaches all the limitations of the claims as stated in the 35 USC 103(a) rejection above. It does not teach the preservatives of instant claim 11.

Tachibana does teach that the composition contains preservatives. The preservatives of instant claim 11 are conventional substances used in the cosmetic art.

According to Hawley, disodium ETA, phenoxyethanol and methylparaben are all known preservatives. Benzyl alcohol is also known for use in cosmetics.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add any one of the preservatives above to the composition of Tachibana for their known antimicrobial effects.

### **Conclusion**

This is a request for continuing application. All claims are drawn to the same invention claimed in the earlier prosecution and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier prosecution. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina C. Yu  
Patent Examiner



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER